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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,864	12/24/2003	Hideyuki Nojiri	246871US3DIV	9345

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EXAMINER

DESAI, ANISH P

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/743,864

Applicant(s)

NOJIRI, HIDEYUKI

Examiner

Anish Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8, 10, 11 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) 8, 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 10, 11 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/968,985.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/24/03</u> | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-5,7,10,11, and 15-19 drawn to a double eyelid forming tape in the reply filed on 10/28/05 is acknowledged. The traversal is on the ground(s) that the proposed process of making the claimed product by the examiner is not a "materially different" process. The examiner disagrees. However, the examiner notes that the product as claimed can be made by another and materially different process such as one wherein the adhesive is applied to the entire surface of a resiliently elastic sheet member instead. Additionally, the applicant has stated that there is no undue burden on the Examiner to search all the claims because the claimed subject matter is overlapping. In response, the examiner respectfully disagrees with the applicant and takes the position that since the art search required for the Group I, claims 1-5,7,10,11, and 15-19 is not in the same class and subclass as the art search required for the Group II, claims 8,13, and 14, the examining of entire application will cause the undue burden on the Office.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Weld (US 3,266,500).

Weld teaches artificial eyeliner (Figures 3 and 4), which includes a base sheet 11 made of a flexible and conformable material with a pressure sensitive adhesive coating applied on one face of the said base sheet (Column 2, line 8-9).

4. Claims 1-3,5,15,18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Clavin (US 4,653,483).

Clavin teaches cosmetic adhesive tape strips comprising a thin pliable transparent backing material and an adhesive carried on the opposite side surface of the backing material (Column 2, lines 14-17). The adhesive tape has a backing and adhesive such that as to make the strip thin, soft and pliable, strong, tear resistant and easily conformed to body contours (abstract), which reads on a resiliently elastic narrow tape member applied with an adhesive as claimed in claim 1. With respect to claim 2, Clavin teaches that the backing material is made of polyethylene film (Column 5, line 44). Regarding claims 5, 18, and 19 disclose a split peel-off liner 48 with an overlap 56 such that the liner can be split in the middle and removed from the adhesive when the strip is attached to the skin of an upper eyelid (Column 5, lines 1-5). The split peel off liner 48 reads on the claimed release sheet having a breaking point.

5. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Tippetts (US 2,419,922).

Tippetts teaches a process of applying an adhesive or bonding agent to a reinforcing member such as cords (Column 1, lines 4-5). The cord can be stretched (Column 5, lines 70-71).

6. Claims 1-4, 16, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Hodgson (US 3,654,835).

Hodgson teaches adhesive materials for use on animal bodies especially human bodies for surgical, dermatological or cosmetic use. The examples include surgical drapes, adhesive dressings, strips and sheets, and eyeliners (Column 2, lines 74-75, Column 3, lines 1-5). The adhesive is applied on the surface of the backing (Column 1, lines 25-28) and the backing can be elastic backing (Column 10, lines 37-38). With respect to claim 2, the backing can be formed using synthetic polymers (Column 1, lines 39-40). Regarding claims 4, 16, and 17, the adhesive may be applied in a discontinuous manner on the surface of the backing (Column 1, lines 54-55).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clavin (US 4,653,483) in view of Istvan et al. (Text book, *Pressure Sensitive Adhesive Technology*, Marcel Dekker Inc., 1997, Pages 1 and 136).

The invention of Clavin as applied to the base claims 1 and 5 is previously disclosed. Clavin is silent as to teaching a release sheet formed of a silicone paper or a film applied with silicone processing. However, Istvan et al. teach pressure sensitive adhesive medical tapes (see Introduction). According to Istvan et al., a basic release liner is comprised of a paper with a very thin silicone coating, adhering sufficiently to the adhesive to hold the laminates together, but enabling peeling off the release paper from the face material (Chapter 5, Page 136). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use silicone coated release liner as split peel-off release liner of Clavin, motivated by the desire to easily remove the release liner from the face of the adhesive.

9. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodgson (US 3,645,835).

The reference of Hodgson is relied upon as previously disclosed. With respect to claims 10 and 11, although Hodgson does not explicitly teach the "string member", the examiner believes that the disclosure of Hodgson at column 8, lines 49-50 which states that the size and the shape of the suture strip may be varied as desired, depending upon the intended use of the material. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the string member for the suture strip because such a variable would have been recognized by one skilled in the art as dependent upon the intended use of the product. Varying the dimensions of the suture strip does not provide any technical advantages and involves only routine

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skill in the art. As such, the "string member" itself does not render the instant claims unobvious over Hodgson.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-5,7,10-11,and 15-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,733,856 B2 (Hideyuki, Nojiri) in view of Istvan et al. (the text book, Pressure Sensitive Adhesive Technology, Marcel Dekker Inc., 1997, Pages 1 and 136). Claim 1 teaches a double eyelid forming article of manufacture comprising: a resiliently stretchable tape member comprising a synthetic resin material, having an adjustable length and having flat upper and lower surfaces; a layer of adhesive on at least one of

the upper and lower surfaces of the tape member; and at least one release sheet having a breaking point configured to break when the tape member is being stretched, the at least one release sheet being located on the layer of adhesive which is located on at least one of the upper and lower surfaces of the tape member, wherein the tape member is configured to provide a sufficient amount of recoil after adhered on an eyelid such that the tape member breaks into the eyelid and forms a fold in the eyelid; and the breaking point is a notched groove formed substantially at a center portion of a length of the at least one release sheet. Claim 2 teaches a double eyelid forming article of manufacture comprising: a resiliently stretchable string member comprising a synthetic resin material, having an adjustable length and having arcuate upper and lower surfaces; a layer of adhesive on at least one of the upper and lower surfaces of the string member; and a releasable jacket covering the string member and having a breaking point configured to break when the string member is being stretched, the breaking point being located substantially at a center portion of the string member, wherein the string member is configured to provide a sufficient amount of recoil after adhered on an eyelid such that the tape member breaks into the eyelid and forms a fold in the eyelid.

Nojiri is silent with respect to teaching a release sheet formed of silicone paper or a film applied with silicone processing. However, Istvan et al. teach pressure sensitive adhesive medical tapes (see Introduction). According to Istvan et al., a basic release liner is comprised of a paper with a very thin silicone coating, adhering sufficiently to the adhesive to hold the laminates together, but enabling peeling off the release paper from

the face material (Chapter 5, Page 136). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use silicone coated release liner as a release sheet of Nojiri, motivated by the desire to easily remove the release liner from the face of the adhesive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai Vo

**HAI VO
PRIMARY EXAMINER**

APD